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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/782,418	02/13/2001	Paul Feinberg	SONY 3.0-028	1905

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LERNER, DAVID, LITTENBERG,  
KRUMHOLZ & MENTLIK  
600 SOUTH AVENUE WEST  
WESTFIELD, NJ 07090

EXAMINER

JACKSON, JAKIEDA R

ART UNIT

PAPER NUMBER

2655

DATE MAILED: 06/10/2004

6

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/782,418

Applicant(s)

FEINBERG, PAUL

Examiner

Jakieda R Jackson

Art Unit

2655

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 05 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 32,37,38 and 41-43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 4,32,37,38 and 41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 February 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Response to Amendment*

1. In response to the Office Action mailed January 6, 2004, applicant submitted an Amendment filed on April 5, 2004, in which the applicant amended claim 32 to include the limitations of claim 40, amended 37, 38 and 41 to reflect the proper dependency originating from claim 32 rather than claim 31 and claims 42-43 are original claims. All other claims have been cancelled. Applicant has requested reconsideration of the application.

2. Applicant's amendments have been fully considered but they are moot in view of new grounds of rejection.

### *Claim Objections*

3. **Claims 41-43** are objected to because of the following informalities:

- **Claims 41-43** refer to a method when depending on an apparatus claim and for examination purposes have been interpreted as apparatus claims.

Appropriate corrections are required

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 32, 37-38 and 41-43** are rejected under 35 U.S.C. 103(a) as being unpatentable over Gabai et al. (U.S. Patent No. 6,160,986), hereinafter referenced as Gabai in view of Hayashi (U.S. Patent No. 6,722,989).

Regarding **claim 32**, Gabai discloses a customizing apparatus comprising:

a) a customizing device (personalize device) having a first processor under control of programs (application software program) and a first storage device (computer's storage unit) having a first program for requesting customizing information (request user to pronounce secret name) for customizing a video game (game; column 14, lines 47-61 with column 11, line 55, column 1, lines 22-26 and column 4, lines 7-19) and receiving said customizing information and personalizing information (column 14, lines 47-61);

b) a video game device, having a second processor (computer in communication with one or more computers; column 11, lines 9-12) under control of said programs (controller) and a second storage device (memory; column 11, lines 48-67) adapted to receive information from said customizing device (column 11, lines 58-64); and

c) said personalizing information being selected based upon a personal profile so that said video game appears familiar with said user after said video game is customized (column 11, lines 8-20 with line 55), but lacks having a second program used in connection with running video game software.

Hayashi discloses a virtual pet game in which the virtual pet can converse with the player and learn new words and phrases from these conversations, that game comprising:

a second program used in connection with running video game software (figure 13; slave/master; column 12, lines 20-28), which allows inputting and outputting data at high speed.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Gabai's invention such that it has a second program used in connection with running video game software, to obtain a wider range of applications, which makes it easy to communicate with other equipment (column 2, lines 1-8).

Regarding **claim 37**, Gabai discloses the apparatus wherein said first program comprises a program for receiving customizing information transmitted to said customizing device according to a wireless application protocol (column 11, lines 58-64).

Regarding **claim 38**, Gabai discloses the apparatus wherein said first program comprises a program for receiving customizing information transmitted to said customizing device according to a hypertext transfer protocol (column 50, lines 24-28).

Regarding **claim 41**, interpreted as an apparatus claim, Gabai discloses the apparatus wherein said customizing information comprises game software to be transferred to said game device (column 14, lines 58-61).

Regarding **claim 42**, interpreted as an apparatus claim, Gabai discloses the apparatus wherein said personalizing information (column 4, lines 55-63) comprises an audio clip selected so that said game device appears familiar with the user (column 10, lines 58-60).

Regarding **claim 43**, interpreted as an apparatus claim, Gabai discloses the apparatus wherein said profile includes preferences concerning game content (column 11, lines 47-57).

### ***Conclusion***

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of


the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jakieda R Jackson whose telephone number is 703.305.5593. The examiner can normally be reached on Monday through Friday from 7:30 a.m. to 5:00p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Doris To can be reached on 703. 305.4827. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JRJ  
June 3, 2004

  
SUSAN MCFADDEN  
PRIMARY EXAMINER